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In re application of
Simon Scullion et al.
Serial No. 09/700,512
Filed: November 13, 2000
For: A BEVERAGE

DECISION ON
PETITION

This is a response to the PETITION UNDER 37 C.F.R. §1.181(a) TO WITHDRAW HOLDING OF ABANDONMENT filed April 8, 2004. The petition requests that the abandonment, as set forth in the Notice of Abandonment of March 23, 2004, for failure to timely file a proper reply to the Office letter of December 10, 2002 be withdrawn based on the oral agreement in an interview conducted on January 6, 2003 between the examiner and Applicants' attorney that included a fully responsive election to the August 27, 2002 restriction requirement.

The facts presented in the present Petition are summarized below:

- I. On August 27, 2002, an Office restriction requirement was mailed by the USPTO.
- II. On September 27, 2002, an election response was submitted by the Applicants, wherein Group I was elected.
- III. On December 10, 2002, an Office letter was mailed by the PTO that held the election response of September 27, 2002 to be non-responsive due to failure to additionally elect specie within Group I. This Office communication set forth a one-month period for response.
- IV. On January 6, 2003, before the expiration of the one month time period to respond to the December 10, 2002 Office letter, Applicants' attorney initiated a telephonic interview with the examiner to discuss the December 10, 2002 Office letter. The Petition alleges that the examiner agreed to issue an Interview Summary that included a fully responsive election to the August 27, 2002 restriction requirement, and that no further written submission was necessary.
- V. On June 6, 2003, before the expiration of the final six month time period to respond to the December 10, 2002 Office letter, Applicants' attorney initiated a second telephonic interview with the examiner to discuss the December 10, 2002 Office letter. The Petition alleges that the examiner again indicated that he would issue an Interview Summary that included a fully responsive election to the August 27, 2002 restriction requirement, and that no further written submission was necessary.
- VI. On March 23, 2004, a Notice of Abandonment was mailed to the Applicant. The Notice of Abandonment stated that the application was abandoned because "the response was by telephone, rather than in writing, as required, the response was improper."

DECISION

The instant request has been accepted as a petition to withdraw the holding of abandonment under the provisions of 37 CFR 1.181 (no fee) - no abandonment-in-fact. This Decision addresses the situation as to whether the oral election on January 6, 2003, in response to the December 10, 2002 Office letter, was sufficient to establish that the reason for holding the September 27, 2002 response to restriction requirement not fully responsive was a proper reply in this particular application. The December 10, 2002 Office communication set forth a time

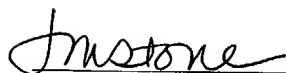
period of one month or thirty days (whichever is longer) for the Applicants "to supply the omission or correction in order to avoid abandonment."

As set forth in 37 CFR 1.2, "[a]ll business with the Patent and Trademark Office should be transacted in writing... The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt." However, as stated in MPEP 713.04, "[t]he action of the USPTO cannot be based exclusively on the written record in the Office if that record is itself incomplete through failure to record the substance of interviews." Moreover, MPEP 713.04, states that it is both the responsibility of: (A) the applicants or the attorney to timely make the substance of an interview of record in the application file; and (B) the examiner to complete an Interview Summary form PTOL-413 of record in each interview where a matter of substance has been discussed.

In the present application, while both the applicants' attorney and examiner erred in not timely making the substance of the interview of January 6, 2003 of record in the official application record, there does not appear to be any doubt as to whether there was a telephonic interview conducted on January 6, 2003 that resulted in a fully responsive election to the August 27, 2002 restriction requirement, as is evidenced by the examiner's reason for the holding of abandonment. Accordingly, 37 CFR 1.2 permits the PTO to treat the non-written agreement or promise as fulfilling the December 10, 2002 Office communication's requirement "to supply the omission or correction in order to avoid abandonment." This Decision herein instructs the examiner to do such, in addition to completing an Interview Summary form PTOL-413 that sets forth the substance of the January 6, 2003 applicant initiated interview.

The Petition is **GRANTED**.

The application shall be forwarded to the examiner for prompt completion of an Interview Summary form PTOL-413 that sets forth the substance of the January 6, 2003 interview. Thereafter, the application will be forwarded to the examiner for processing and an Office action on the merits shall follow in due course.



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